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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/770,139

02/02/2004

John P. Downs

5398-CIP-CON-3

9662

22922

7590

07/27/2006

EXAMINER

AHMAD, NASSER

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ART UNIT

PAPER NUMBER

1772

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No.	Applicant(s)	
	10/770,139	DOWNS, JOHN P.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-16,18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-16,18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 5/11/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6640864 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Rejections Maintained

2. Claims 1, 3-4, 6-7, 9-11 and 14-15 rejected under 35 USC 102(b) as being anticipated by Torrey for reasons of record made in the last Office action of December 8, 2005.

3. Claims 1, 3-7, 9-16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey for reasons of record made in the last Office Action.

Response to Arguments

4. Applicant's arguments filed 5/11/2006 have been fully considered but they are not persuasive.

Applicant's response to the query is noted.

Applicant argues that Torrey does not teach a single row of adhesive segments disposed within a longitudinal segment of the carrier tape. This is not deemed to be convincing because, as shown in figure-4, Torrey shows that there is a single row of adhesive segment disposed within a longitudinal segment of the tape. Further, each adhesive segment is positioned between the two edges of the tape, the adhesive

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segments are non-contiguous and spaced apart longitudinally from each other and each segment of the tape containing each non-contiguous adhesive segment is found to anticipate the claimed invention.

Similarly, Torrey shows that the series of adhesive segments are positioned along the length of the tape as shown in figures 3 and 4. Figure 4 also shows the presence of single row of adhesive segment with one adhesive positioned transversely. Since, in col. 3, lines 66-68, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice. Further, contrary to applicant's position, the claims are not directed to the segments having different transverse position as alleged, rather the claims merely recite that the transverse dimension of the segments are distinct. Thus, claims 1, 7 and 16 are clearly anticipated by Torrey.

Applicant's argument that Torrey's adhesive segments defines that adhesive segments abut, touch or are attached to each other is not found to be persuasive because, as explained in the last Office Action, figure-4 of Torrey clearly shows that the rectangular adhesive segments are non-contiguous. Further, examiner could not locate the definition of *non-contiguous* in Torrey to state that it is *contiguous*, as alleged. Also, Torrey, in col. 6, lines 45-48, discloses that the *substantially non-contiguous* nature of the adhesive is they function as **discrete** segments.

In response to applicant's argument that a single segment of adhesive of Torrey cannot be transferred alone, applicant is directed to Torrey, col. 6, lines 32-34, wherein is stated that "any portion of the adhesive can be transferred", indicating that the adhesive

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segments are individually transferable. In the alternative, said aspect of the adhesive segments being transferred alone is also directed to an intended future use of the claimed product and hence, is not found to be of positive limitation.

Regarding applicant's argument for 35 USC 103(a) rejection, the above explanations apply *a fortiori* herein. Further, regarding the disk shaped adhesive segments, applicant's acknowledgement is noted that in Torrey, the shape or adhesive amount is not critical because any portion of the adhesive can be transferred and that the adhesive segment can have any shape or pattern.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 7/20/06
Primary Examiner
Art Unit 1772

N. Ahmad.
July 20, 2006.